

ESTTA Tracking number: **ESTTA413960**

Filing date: **06/10/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	World Gym International IP, LLC
Granted to Date of previous extension	06/11/2011
Address	1901 Avenue of the Stars, Suite 1100 Los Angeles, CA 90067 UNITED STATES
Attorney information	Elliot B. Gipson Gipson Hoffman & Pancione 1901 Avenue of the Stars, Suite 1100 Los Angeles, CA 90067 UNITED STATES egipson@ghplaw.com, rsilverman@ghplaw.com, mtylke@ghplaw.com, ksidle@ghplaw.com Phone:310-556-4660

Applicant Information

Application No	79071980	Publication date	04/12/2011
Opposition Filing Date	06/10/2011	Opposition Period Ends	06/11/2011
International Registration No.	1010643	International Registration Date	02/19/2009
Applicant	Jacek Waksmundzki ul. Urwisko 4 PL-02-776 Warszawa POLAND		

Goods/Services Affected by Opposition


Class 041. All goods and services in the class are opposed, namely: Consulting in the field of education; information about education; organizing academic competitions
Class 044. All goods and services in the class are opposed, namely: Medical services, namely, conventional and alternative medicine


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1911887	Application Date	06/15/1994
Registration Date	08/15/1995	Foreign Priority Date	NONE
Word Mark	WORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1977/08/01 First Use In Commerce: 1977/08/01 fitness center services, conducting seminars on fitness and providing personal instructions on exercise and physical fitness by manner of individualized courses, gymnasium services, conducting bodybuilding exhibitions and contests		

U.S. Registration No.	1354193	Application Date	12/12/1983
Registration Date	08/13/1985	Foreign Priority Date	NONE
Word Mark	WORLD GYM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/08/01 First Use In Commerce: 1977/08/01 GYM CLOTHING		


U.S. Registration No.	1783000	Application Date	10/08/1992
Registration Date	07/20/1993	Foreign Priority Date	NONE
Word Mark	WORLD GYM		
Design Mark			
Description of	NONE		


Mark	
Goods/Services	Class 041. First use: First Use: 1977/08/01 First Use In Commerce: 1977/08/01 gymnasium services; conducting bodybuilding exhibitions and contests

U.S. Registration No.	1791584	Application Date	10/08/1992
Registration Date	09/07/1993	Foreign Priority Date	NONE
Word Mark	WORLD GYM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1977/08/01 First Use In Commerce: 1977/08/01 printed publications; namely, magazines and informational brochures pertaining to bodybuilding, health and nutrition and gymnasium products and services; posters; decorative adhesive stickers Class 041. First use: First Use: 1977/08/01 First Use In Commerce: 1977/08/01 gymnasium services; conducting bodybuilding exhibitions and contests		

U.S. Registration No.	2268311	Application Date	10/17/1997
Registration Date	08/10/1999	Foreign Priority Date	NONE
Word Mark	WORLD GYM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1996/02/00 First Use In Commerce: 1996/02/00 shirts, shorts, pants, sweat suits, jackets, hats, gloves		

U.S. Registration No.	2499267	Application Date	10/01/1997
Registration Date	10/23/2001	Foreign Priority Date	NONE
Word Mark	WORLD GYM		

Design Mark	
Description of Mark	The mark comprises the words "WORLD GYM" and stylized designs of a gorilla and a globe of the Earth.
Goods/Services	Class 041. First use: First Use: 1996/02/00 First Use In Commerce: 1996/02/00 fitness center services, gymnasium services, conducting seminars on fitness and providing personal instructions on exercise and physical fitness by manner of individualized courses, conducting bodybuilding exhibitions, contests conducting exercise classes, conducting seminars on nutrition and fitness

U.S. Registration No.	1856427	Application Date	12/24/1992
Registration Date	09/27/1994	Foreign Priority Date	NONE
Word Mark	WORLD GYM FITNESS CENTERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1992/11/00 First Use In Commerce: 1992/11/00 fitness center services, conducting exercise classes, conducting seminars on nutrition and fitness and providing personal instructions on nutrition, exercise and physical fitness		

Attachments	73456674#TMSN.gif (1 page)(bytes) 74320861#TMSN.gif (1 page)(bytes) 75375423#TMSN.gif (1 page)(bytes) 75366522#TMSN.gif (1 page)(bytes) 74343066#TMSN.gif (1 page)(bytes) NOTICE OF OPPOSITION.pdf (13 pages)(470982 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Elliot B. Gipson/
Name	Elliot B. Gipson
Date	06/10/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of appxication Serial No. 79071980
Filed February 9, 2009
For the mark WORLD [X][X]
Published in the Official Gazette on January 18, 2011

WORLD GYM INTERNATIONAL IP, LLC :

Opposer,

v.

JACEK WAKSMUNDZKI,

Applicant.

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Opposition No. _____

Filed electronically via ESTTA

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

The Opposer World Gym International IP, LLC (“World Gym” or “Opposer”) believes it will be damaged by registration of the WORLD [X][X] mark applied for by Jacek Waksmundzki (“Applicant”) as shown in Serial No. 79071980 hereby opposes the same.

The grounds for opposition are as follows:

GENERAL ALLEGATIONS

1. World Gym is the owner of certain World Gym related marks, including m arks registered in the United States and throughout the world. These m arks are registered in classes 16, 25 and 41 used in association with health and fitness products and services in the United States and throughout the world. The World Gym brand was founded by fitness guru Joe Gold in

1976 and has accumulated great value and name recognition by its continuous presence in the health and fitness marketplace for more than thirty years.

2. The WORLD GYM family of marks is instantly recognizable to consumers and is a valuable asset of Opposer. Opposer and Opposer's predecessors-in-interest have continuously used the WORLD GYM family of marks in commerce for at least the last 30 years.

3. World Gym owns the following trademark registrations on the principal register in the United States Patent and Trademark Office:

REG.	MARK	CLASSES	GOODS OR SERVICES
1911887	WORLD	41	Fitness center services, conducting seminars on fitness and providing personal instructions on exercise and physical fitness by manner of individualized courses, gymnasium services, conducting bodybuilding exhibitions and contests.
1354193	WORLD GYM	25	Gym clothing
1783000	WORLD GYM	41	Gymnasium services; conducting bodybuilding exhibitions and contests.
1791584	WORLD GYM	16	Printed publications; namely, magazines and informational brochures pertaining to bodybuilding, health and nutrition and gymnasium products and services; posters; decorative adhesive stickers.

REG.	MARK	CLASSES	GOODS OR SERVICES
1791584	WORLD GYM	41	gymnasium services; conducting bodybuilding exhibitions and contests.
2268311	WORLD GYM	25	Shirts, shorts, pants, sweat suits, jackets, hats, gloves.
2499267	WORLD GYM	41	Fitness center services, gymnasium services, conducting seminars on fitness and providing personal instructions on exercise and physical fitness by manner of individualized courses, conducting bodybuilding exhibitions, contests conducting exercise classes, conducting seminars on nutrition and fitness.
1856427	WORLD GYM FITNESS CENTERS	41	Fitness center services, conducting exercise classes, conducting seminars on nutrition and fitness and providing personal instructions on nutrition, exercise and physical fitness.

4. On February 9, 2009 Applicant, with an address in Poland, applied to register WORLD [X] [X] in seven classes, including:

CLASS	DESCRIPTION
35	Services in the field of acquiring, searching for, of elaborating, systematizing and making commercial information available through computer terminals, namely, business advice and commercial information; services of the call centre, namely,

CLASS	DESCRIPTION
	operation of telephone call centers for others ; consulting services in the field of organizing and leading business activity; personnel management; services in the field of advertising, namely, distribution of samples, prints, brochures, booklets and advertising brochures; advertising services; advertising through computer networks; mediation of trade business for third parties in the field of the employment exchange and workers' selection; market research and examination of public opinion surveys; compilation and systemization of information into computer databases
36	Consulting and information in financial and insurance matters; financial valuation in the fields of insurance, banking and property
38	Transfer of data by telecommunication, namely, transferring text and graphic information through computer terminals, satellites, optical networks, and e-mail
41	Consulting in the field of education; information about education; organizing academic competitions
42	Upgrading of software; design of computer systems
44	Medical services, namely, conventional and alternative medicine
45	Intellectual property consultancy; copyright management

5. Applicant's proposed mark and Opposer's marks are nearly identical.

6. Applicant's proposed mark prominently displays the word WORLD in all uppercase letters and uses a globe to substitute for the letter O. *See Exhibit A attached hereto (a copy of the drawing attached to Applicant's application).*

7. Opposer's registration numbers 1856427, 2499267, and 226831 prominently display the word WORLD in all uppercase letters and use a globe to substitute for the letter O. See Exhibit B attached hereto (Opposer's mark registration numbers 1856427, 2499267, and 226831).

8. Applicant's application was initiated without license, authorization or permission from Opposer.

9. Applicant is proposing to use its WORLD [X][X] mark in a manner similar to Applicant's use and for related services in classes 41 and 44.

10. The registration of Applicant's WORLD [X][X] mark as shown in application number 79071980 will harm Opposer.

FIRST CLAIM FOR RELIEF

LIKLIHOOD OF CONFUSION FOR CLASSES 41 AND 44

11. Opposer repeats and realleges each and every allegation contained in paragraphs 1 through 10 as if fully set forth herein.

12. Opposer has used the WORLD GYM marks since a date long prior to any date on which Applicant may rely.

13. Applicant's mark is confusingly similar to Opposer's long-established WORLD GYM marks.

14. The services offered under Applicants marks in classes 41 and 44 are identical and/or closely related to Opposer's services under the WORLD GYM marks.

15. Potential purchasers of such services are likely to believe that Applicant and/or Applicant's services offered under the WORLD [X][X] mark originate with, are sponsored or endorsed by, or are otherwise associated or connected with Opposer. The use of the WORLD

[X][X] mark in connection with the opposed services is, therefore, likely to cause confusion, mistake or deception in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

SECOND CLAIM FOR RELIEF

DILUTION FOR CLASSES 41 AND 44

16. Opposer repeats and realleges each and every allegation contained in paragraphs 1 through 15 as if fully set forth herein.

17. Opposer's WORLD GYM family of marks is world famous in the health and fitness market.

18. Applicant's WORLD [X][X] mark in classes 41 and 44 would dilute the distinctive quality of Opposer's WORLD GYM family of marks.

19. Registration of Applicant's WORLD [X][X] mark in classes 41 and 44 would therefore hurt and damage Opposer.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that application number 79071980 for the mark WORLD [X][X] in classes 41 and 44 be refused.

DATED: June 10, 2011

Respectfully submitted,

GIPSON HOFFMAN & PANCIONE
A Professional Corporation
ELLIOT B. GIPSON

By: _____

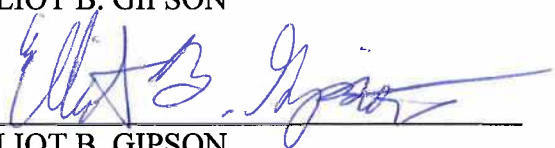

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EXHIBIT A



EXHIBIT B

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent and Trademark Office

Reg. No. 1,856,427

Registered Sep. 27, 1994

**SERVICE MARK
PRINCIPAL REGISTER**



WORLD GYM LICENSING, LTD. (CALIFORNIA CORPORATION)
3110 MAIN STREET, SUITE 205
SANTA MONICA, CA 90405

FOR: FITNESS CENTER SERVICES, CONDUCTING EXERCISE CLASSES, CONDUCTING SEMINARS ON NUTRITION AND FITNESS AND PROVIDING PERSONAL INSTRUCTIONS ON NUTRITION, EXERCISE AND PHYSICAL FITNESS, IN CLASS 41 (U.S. CL. 107).

FIRST USE 11-0-1992; IN COMMERCE 11-0-1992.

OWNER OF U.S. REG. NO. 1,354,193.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GYM FITNESS CENTERS", APART FROM THE MARK AS SHOWN.

SN 74-343,066, FILED 12-24-1992.

KEVIN PESKA, EXAMINING ATTORNEY

Int. Cl.: 41

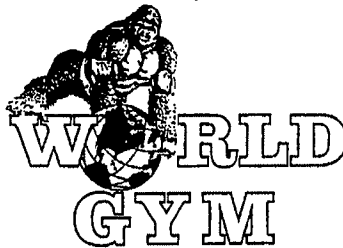
Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 2,499,267

Registered Oct. 23, 2001

SERVICE MARK
PRINCIPAL REGISTER



WORLD GYM LICENSING, LTD. (CALIFORNIA
CORPORATION)
2210 MAIN STREET
SANTA MONICA, CA 90405

OWNER OF U.S. REG. NOS. 1,354,193, 1,911,887
AND OTHERS.

FOR: FITNESS CENTER SERVICES, GYMNA-
SIUM SERVICES, CONDUCTING SEMINARS ON
FITNESS AND PROVIDING PERSONAL INSTRU-
CTIONS ON EXERCISE AND PHYSICAL FITNESS BY
MANNER OF INDIVIDUALIZED COURSES, CON-
DUCTING BODYBUILDING EXHIBITIONS, CON-
TESTS CONDUCTING EXERCISE CLASSES,
CONDUCTING SEMINARS ON NUTRITION AND
FITNESS, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "GYM", APART FROM THE MARK
AS SHOWN.

THE MARK COMPRISES THE WORDS "WORLD
GYM" AND STYLIZED DESIGNS OF A GORILLA
AND A GLOBE OF THE EARTH.

SER. NO. 75-366,522, FILED 10-1-1997.

FIRST USE 2-0-1996; IN COMMERCE 2-0-1996.

G. T. GLYNN, EXAMINING ATTORNEY

Int. Cl.: 25

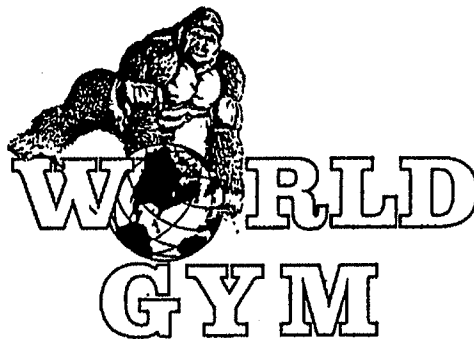
Prior U.S. Cls.: 22 and 39

Reg. No. 2,268,311

United States Patent and Trademark Office

Registered Aug. 10, 1999

**TRADEMARK
PRINCIPAL REGISTER**



WORLD GYM LICENSING, LTD. (CALIFORNIA CORPORATION)
2210 MAIN STREET
SANTA MONICA, CA 90405

FOR: SHIRTS, SHORTS, PANTS, SWEAT SUITS, JACKETS, HATS, GLOVES, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 2-0-1996; IN COMMERCE 2-0-1996.

OWNER OF U.S. REG. NOS. 1,354,193, 1,911,887 AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GYM", APART FROM THE MARK AS SHOWN.

SER. NO. 75-375,423, FILED 10-17-1997.

G. T. GLYNN, EXAMINING ATTORNEY

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served upon the attorney for Jacek Waksmundzki, by first class mail, postage prepaid to: Horst M. Kasper, Kasper and Laughlin, 13 Forest Drive, Warren, NJ 07059.

Dated: June 10, 2011

By: Marsha Tylke
Marsha Tylke

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on the date shown below.

Dated: June 10, 2011

By: Marsha Tylke
Marsha Tylke

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